

REMARKS

Applicants have canceled claims 1-11 and 14-15 without prejudice.

Applicants have amended claim 12 to recite a pharmaceutical composition comprising a D- or L-tryptophanyl-ester or its N-acyl derivative of a certain formula for the prophylaxis and/or therapy of oxidative pathologic processes in degenerative diseases and cancer, alone or in combination with a second therapeutic compound. Support for this amendment can be found, for example, on page 6, lines 4-10 and page 7, lines 23-26 of the specification.

Applicants have added claims 18-28 also directed to pharmaceutical compositions of this invention. Support for claims 18-20 may be found, *inter alia*, on page 6, lines 4-10 of the specification. Support for claims 21-23 may be found, *inter alia*, on page 7, lines 27-34. Support for the claims 24-28 may be found, *inter alia*, in claims 5, 6 and 12 as originally filed.

Claims 12 and 16-28 are now pending. Applicants reserve the right to pursue any non-elected or canceled subject matter in subsequent applications claiming benefit herefrom.

The Restriction Requirement

The Examiner has required restriction of the claims in this application under 35 U.S.C. § 121 to one of the following groups:

Group I: Claims 1-11, and 14, drawn to a method of treating or preventing degenerative disease.

Group II. Claims 12, and 15-17, drawn to Claims 12, and 15-17, drawn to a pharmaceutical composition comprising D- or L-tryptophanyl ester or its N-acyl derivatives.

The Examiner contends that the inventions I and II are patentably distinct and that they are related as process of use and product, respectively. The Examiner states that the inventions are patentably distinct because (1) the method of treating a degenerative disease as claimed can be practiced with another materially different product and (2) the inventions have acquired separate status in the art because of their recognized divergent subject matter.

In response to this requirement, applicants elect the subject matter of Group II (claims 12, and 15-17) for examination in this application without traverse. As discussed above, applicants have canceled claim 15 without prejudice and added claims 18-28 directed to pharmaceutical compositions of this invention. Applicants request that the Examiner consider added claims 18-28 with the claims of Group II in this application.

Election of species

The Examiner has required applicants to elect a single disclosed species of disease or disorder. The Examiner has identified two species from which an election is to be made: degenerative and/or cancer diseases. The Examiner states that due to the very different nature, pathology, and consequently different treatment modalities for each disease, the search field for each disease state encompassed by the claims would differ and the search for all the species would impose an undue burden. Applicants traverse the election of species requirement.

All the pending claims (i.e., amended claim 12, claims 16-17 and added claims 18-28) are directed to pharmaceutical compositions comprising a D- or L-tryptophanyl-ester or its N-acyl derivative. Added claim 18 and claims depending therefrom are directed to a pharmaceutical composition comprising a compound selected from a genus of D- or L-tryptophanyl-esters or their N-acyl derivatives. Added claim 21, which depends from claim 18, recites the pharmaceutical composition of claim 18 that further comprises a second therapeutic compound. Added claim 22, which depends from claim 12 or 21, recites the pharmaceutical composition of claim 12 or 21, wherein the second therapeutic compound is for treating a degenerative disease or cancer. Accordingly, a search for a pharmaceutical composition comprising a D- or L-tryptophanyl-ester or its N-acyl derivative would encompass pharmaceutical compositions of this invention that further comprise a compound for treating a degenerative disorder or cancer. Thus, there is no search burden to examine any pharmaceutical composition comprising a D- or L-tryptophanyl-ester or its N-acyl derivative in combination with a compound for treating a degenerative disease or cancer. For these reasons, applicants request that the requirement for species election be withdrawn.

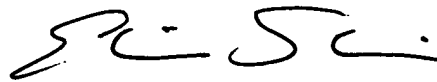
As required by the Examiner, applicants provisionally elect with traverse degenerative diseases as a single disclosed species of diseases for initial examination.

The claims that read upon the elected species are amended claim 12, claims 16-17, and added claims 18-28.

CONCLUSION

Applicants request that the Examiner enter the amendments and added claims, consider the foregoing remarks and allow the pending claims.

Respectfully submitted,



James F. Haley, Jr. (Reg. No. 27,794)

Elinor K. Shin (Reg. No. 43,117)

Attorneys for Applicants

c/o FISH & NEAVE

1251 Avenue of the Americas

New York, New York 10020-1104

Telephone (212) 596-9000